

Application No. 10/552,335

Attorney Docket: 2017-31

REMARKS

This is in response to the Office Action dated October 30, 2006. Applicant has amended the application as set forth above. In more specific, claims 1-2 have been canceled without prejudice, and claims 3-5 have been added. All the features of the added claims are fully supported by the originally filed application including the original claims 1-2, line 22, page 3 through line 24, page 4 of the original specification, and Figs. 1 through 14. Thus, the amendments do not add new matter to the application. Upon the entry of the amendments, claims 3-5 are pending in this application. Applicant respectfully requests the entry of the amendments and reconsideration of the application.

Requirement of Reference to the Priority Applications

The Examiner pointed out that a reference to the prior application must be inserted as the first sentence(s) of the specification of the present application. Applicant has amended the specification as discussed in the above.

Claim Objections

The Examiner objected claims 1 and 2 because of the informalities. Applicant has canceled claims 1-2. Therefore, this objection is moot. Withdrawal of the objection is respectfully requested.

Claim Rejections under 35 U.S.C. §112, second paragraph

The Examiner rejected claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has canceled claim 1. Therefore, this rejection is moot. Withdrawal of the rejection is respectfully requested.

Claim Rejections under 35 U.S.C. §102

The Examiner rejected claim 2 under 35 U.S.C. §102(b) as being anticipated by MCKINNEY (US Patent No. 2,594,966). Applicant respectfully disagrees with the Examiner. However, Applicant has canceled claim 2. Therefore, this rejection is moot. Withdrawal of the rejection is respectfully requested.

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Claim Rejections under 35 U.S.C. §103

The Examiner rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over HENNING (US Patent No. 4,678,079) in view of MCKINNEY. Applicant respectfully disagrees with the Examiner. However, Applicant has canceled claim 1 solely to expedite the prosecution of the application. Therefore, this rejection is moot. Withdrawal of the rejection is respectfully requested.

Patentability of Pending Claims over Cited References

Regardless of the moot status of the rejections under sections 102 and 103, Applicant discusses the patentability of claims 3-5 over the cited references.

MCKINNEY Does not Anticipates Pending Claims 3-5

Applicant respectfully submits that the new claims 3-5 are not anticipated by MCKINNEY.

The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, the finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001).

Disclosure of MCKINNEY

MCKINNEY discloses a clothes hanger including a hook (12), a horizontal supporting rod (11), and horizontally-extending arms (20, 21, 22, and 23) connected to the horizontal supporting rod (12). Each of the horizontally-extending arms (20, 21, 22, and 23) is adapted to extend through the belt loops. In other words, the horizontally-extending arms (20, 21, 22, and 23 in Fig. 1; 35, 36, 37, and 38 in Fig. 2) are connected to the lower portion of the clothes

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hanger (11 in Fig. 1; 39 in Fig. 2). Therefore, the top part other than the hook of the clothes hanger is still upwardly bent with the portions (13 and 14) (See, e.g., col. 1, lines 37-40; col. 2, lines 1-29; col. 2, lines 49-54; Figs. 1-3).

MCKINNEY Does Not Anticipate Claim 5

Claim 5, corresponding to the original claim 2, is directed to a coat hanger comprising an upper end portion and a beam. The features include: the beam is extended from both side of the upper end portion; and the beam is shorter than the whole length of the coat hanger.

As discussed above, MCKINNEY discloses the horizontally-extending arms connected to the lower portion of the clothes hanger.

The coat hanger of the present invention comprises an upper end portion and a beam extending from both sides of the upper end portion of the coat hanger, wherein the beam is aligned with at least one of the dotted line when the coated packing paper is folded and wrapped. Since the beam is extended from the upper end portion, the beam makes the top line of the coat hanger when wrapped and packaged is horizontal, but not drooped as in MCKINNEY. Because of the horizontal top line of the coat hanger, the present invention can provide a coat hanger shopping bag, which is substantially rectangular, when the garments on the coat hanger is wrapped and packaged by the coated packing paper.

In view of foregoing, MCKINNEY does not anticipate the new claim 5. Applicant respectfully requests withdrawal of the rejections.

Prima Facie Case of Obviousness

The Patent and Trademark Office has the burden under section 103 to establish a *prima facie* case of obviousness. In re *Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, the prior art reference (or references when combined) must teach or suggest all the claim limitations; second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; finally, there must be a reasonable expectation of success. M.P.E.P. §2143.

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Disclosure of HENNING

HENNING teaches a paper-board container including a top wall (84), integral hanger (92), and a handle section (87) connected to the top wall (84) through a fold line (88) (See, e.g., col. 5, lines 41-57, Abstract, and Figs. 1 and 3-4).

No Prima Facie Case of Obviousness Has Been Established

As discussed, HENNING does not teach or suggest the claimed features of claim 3 corresponding to the original claim 1. HENNING does not suggest a handhold as well as the beam. HENNING's handle section is an extension of the paper-board container, not an extension of the coat hanger. Also, MCKINNEY does not remedy the deficiencies of HENNING. MCKINNEY discloses a hook (12). However, MCKINNEY's hook is for suspending the clothes hanger, but not for carrying by a hand. As such, the combination of HENNING and MCKINNEY does not provide every element of claims 3 and its dependent claim 4. Therefore, the combination does not establish a *prima facie* case of obviousness. Applicant respectfully requests allowance of claims 3 and 4.

Dependent Claims

Although applicant has not addressed all the issues of the dependent claims, applicant respectfully submits that applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the examiner, and applicant submits that each claim is patentable on its own merits. Claims 4 is dependent either directly or indirectly on claim 3. Therefore, Applicant respectfully requests prompt allowance of the claims.

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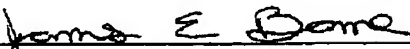
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CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that claims 3-5 are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectively submitted,

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